REMARKS

Reconsideration and allowance of the above identified patent application are respectfully requested. This application relates to 3-(cyclopropylmethoxy)-5,5-dimethyl-4-(4-(methylsulfonyl)phenyl)-5H-furan-2-one and 3-(1-cyclopropyl-ethoxy)-5,5-dimethyl-4-(4-(methylsulfonyl)phenyl)-5H-furan-2-one as COX-2 inhibitors.

Claims 1-6 are pending in the application. The Examiner provisionally rejected Claims 1-6 under 35 U.S.C. § 101 for statutory double patenting over copending application no. 09/097,543 ('543). Claims 1-6 were also provisonally rejected under the judicially created doctrine of obviousness-type double patented over Claim 31 of the '543 application. The Examiner also objected to the Abstract of the Invention alleging that it was not drawn to the invention claimed.

The Abstract of Invention has been deleted and replaced with an abstract that is drawn to the invention claimed. The Examiner's requirement of correction is therefore complied with.

With regard to the rejection of Claims 1-6 for statutory double patenting, the Applicants contend that no basis for such a rejection exists because the same invention is not claimed in both Claims 1-6 of this application and Claim 1 of the '543 application. "Same invention" means identical subject matter. M.P.E.P § 804(II)(A) (July 1998). If an embodiment of the invention falls within the scope of one of the claims but not the other than there is no statutory double patenting. The M.P.E.P. give an illustrative example:

> ... the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantially the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." M.P.E.P § 804(II)(A) (July 1998).

Likewise, in *In re Goodman*, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993), the Federal Circuit held that a genus claim and a claim to a species of the genus are not the "same invention" for purposes of statutory double patenting. *See Id.* at 2015. The Examiner should be guided by the examples cited above. Claim 1 of the '543 application is a generic claim while Claims 1-6 of the instant application are drawn to a species. Since Claims 1-6 are drawn to a different invention than the genus of the '543 patent, the statutory double patenting rejection is improper and should be withdrawn.

With regard to the rejection of Claims 1-6 for obviousness-type double patenting over Claim 31 of the '543 application, the Examiner identifies one compound in Claim 31 of the '543 application that was of concern. Applicants have submitted a Preliminary Amendment in the '543 application coincident with this Amendment that deletes compound 41 of Claim 31. This Amendment adds Claim 7 which is an independent claim to the species deleted in the copending application. Claim 7 complies with the written description requirement of 35 U.S.C. § 112 since the species is disclosed in the Specification. See Example 134, p. 187, l. 5; Examples 146 and 147, p.193, l. 11. Since the Examiner rejected Claims 1-6 as obvious over the specific compound in Claim 31, the removal of that species overcomes the rejection.

Claims 8-12 have also been added and are directed to compositions and methods of treatments relating to Claim 7.

Applicants submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Amendment may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

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